

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 1-268.

The following claims are *independent*: 1, 58, 116, 173, 230, 236, 242, 248, 254.

Please *amend* claims 1, 58, 116, 173, 230, 236, 242, 248, 254; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices (hereinafter “amendment,” “amendments,” and/or “amended”), Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claims 1-10, 12, 14-16, 19-27, 29-35, 39-41, 44-47, 58-67, 69, 71-73, 76-84, 86-93, 97-99, 102-105, 116-125, 127, 129-131, 134-142, 144-150, 154-156, 159-162, 173-182, 184, 186-188, 191-199, 201-207, 211-213, 217-219, 254-258, 260-268 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Paul, US Publication No. 2003/0171982 (hereinafter “Paul”), in view of Brockenbrough, et al., US Publication No. 2002/0065097 (hereinafter “Brockenbrough”). The Office Action rejected claims 11, 13, 17-18, 28, 36-38, 42-

43, 48-54, 68, 70, 74-75, 85, 94-96, 100-101, 106-108, 112, 126, 128, 132-133, 143, 151-153, 157-158, 163-165, 169, 183, 185, 189-190, 200, 208-210, 214-215, 220-222, 226, 259 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Paul, in view of Brockenbrough, and in further view of Foroutan, US Patent No. 7,162,433 (hereinafter “Foroutan”). The Office Action rejected claims 51-53, 109-111, 166-168, 223-225 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Paul, in view of Brockenbrough, in view of Foroutan, and further in view of Jokipii et al, US Publication No. 2003/0190960 (hereinafter “Jokipii”). The Office Action rejected claims 55-57, 113-115, 170-172, 227-229 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Paul, in view of Brockenbrough, in view of Foroutan, and further in view of Von Kohorn, US Patent No. 5,916,024 (hereinafter “Von Kohorn”). The Office Action rejected claims 230-233, 236-239, 242-245, 248-251 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Jokipii, in view of Foroutan, and further in view of Brockenbrough. The Office Action rejected claims 234-235, 240-241, 246-247, 252-253 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Jokipii, in view of Foroutan, in further view of Brockenbrough, and further in view of Paul.

Requirements to Establish Prima Facie Obviousness

The Supreme Court in *Graham v. John Deere Co. of Kansas City* prescribed that a *prima facie* showing of obviousness under 35 U.S.C. § 103 requires that, "the obviousness or nonobviousness of the subject matter [be] determined," and details further requirements, commonly referred to as “Graham factors,” which include that “[1] the scope and content of the prior art [be] determined, [2] differences between the prior art and the claims at issue [be] ascertained, and [3] the level of ordinary skill in the pertinent art [be] resolved.” *Graham*, 383 U.S. at 1, 17 (1966). To comply with the Graham factors, as introduced in 3447840-1

Graham and reaffirmed in *KSR Intern. Co. v. Teleflex Inc.*¹, MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;
- (B) the difference or differences in the claim over the applied reference(s);
- (C) the proposed modification of the applied reference(s) to arrive at the claimed subject matter; and
- (D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

The MPEP prescribes that, “when evaluating the scope of a claim, *every limitation in the claim must be considered*,” (§ 2106 II(C), emphasis added) and, “*All words in a claim must be considered in judging the patentability of that claim against the prior art.*” (§ 2143.03, emphasis added). Applicant submits that the pending rejection has failed to consider “every limitation in the claim” and “[a]ll words in [the] claim” in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s). As with this Office Action, when the Examiner mischaracterizes and/or provides references that are missing claimed elements, then the Examiner has failed to fulfill MPEP § 706.02(j) requirements (A) and/or (D), and as a consequence, has failed to establish a *prima facie* case of obviousness. 35 U.S.C. § 103.

¹ The “[Graham] factors continue to define the inquiry.” 550 U.S. 398 (2007).

Missing Claim Element(s)

Applicant submits the cited references (taken alone or in combination) do **not** discuss, do **not** render obvious, and are in fact missing at least the following element(s) as recited, *inter alia*, in previously presented independent claim 1:

A creative work evaluating processor-implemented method, comprising:

...

providing via a processor an offer to compete by a first user, wherein the offer to compete includes parameters that specify a second user as a potential competitor and competition rules;

...

The Office Action asserts the above claimed elements are shown in Brockenbrough.

The Examiner admits that:

Paul does not explicitly disclose wherein the offer to compete includes parameters that specify a second user as a potential competitor and competition rules; (Office Action, p. 5).

However, the Examiner attempts to remedy this deficiency in Paul by relying on Brockenbrough and alleging that:

Brockenbrough discloses this limitation (see ... paragraph 32, disclosing allowing the host to set rules); (Office Action, p. 5).

Applicant disagrees and submits the Office Action mischaracterized Brockenbrough and hereby traverses.

Contrary to the Office Action's assertions, Applicant submits that Brockenbrough essentially discusses a *mobile phone gaming system in which disposition options determine what happens when a player leaves a currently in progress game to take a phone call*. In Brockenbrough, "if mobile client 28 decides to take the call ... a message ... for each of the other players in the game ... will describe the disposition of their [in progress] session,"

(Brockenbrough, paragraph [0031]). Brockenbrough continues, "disposition options include hold, suspend, replace or drop, and may vary based on game requirements," (Brockenbrough, paragraph [0032]). Brockenbrough explains, "the host of the game may set certain attributes such as the length of time between moves. Based on these attributes, the disposition options for a particular game are set," (Brockenbrough, paragraph [0032]). Accordingly, Applicant submits that Brockenbrough's *mobile phone gaming system in which disposition options determine what happens when a player leaves a currently in progress game to take a phone call*, is different from at least the previously claimed "providing via a processor an offer to compete by a first user, wherein the offer to compete includes parameters that specify a second user as a potential competitor and competition rules," much less of the currently claimed:

providing via a processor an offer to compete by a first user,
wherein the offer to compete includes parameters that specify a
second user as a potential competitor and creative work
evaluating competition rules;

as recited in amended claim 1.

Should the Examiner maintain the rejection, Applicant respectfully requests that the Examiner provide specific citations and explanations describing how each and every element of the pending claims are allegedly rendered obvious by the cited reference, providing indications of specific, alleged correspondences between claim elements and cited portions of the applied reference.

Although of different scope than independent claim 1, Applicant submits claims 58, 116, 173, 254 (and as a consequence any claims depending therefrom) are all patentable over the cited references (taken alone or in combination) for at least similar reasons as discussed

above when identifying deficiencies in the Office Action's application of Brockenbrough with regard to independent claim 1. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections and allowance of claims.

Furthermore, claim 254, amended by Applicant in the previous response dated May 21, 2010, recites, *inter alia*, "pair a plurality of competitors based on the acceptance to the offer according to parameters specified in the competition offer fields." Accordingly, Applicant submits competition offer fields should be given patentable weight, and respectfully requests reconsideration and withdrawal of the rejections and allowance of claim.

Similarly, Applicant submits that Foroutan's *system that allows producers to submit content for ranking* fails to remedy the deficiencies identified above in Brockenbrough with regard to independent claim 230 (and as a consequence any claims depending therefrom). For at least the reasons discussed above, Applicant submits that the pending rejection has mischaracterized the language of the claim element(s) and/or the applied references and, thus, has not established a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections and allowance of claims.

Although of different scope than independent claim 230, Applicant submits claims 236, 242, 248 (and as a consequence any claims depending therefrom) are all patentable over the cited references (taken alone or in combination) for at least similar reasons as discussed above when identifying deficiencies in the Office Action's application of Brockenbrough with regard to independent claim 230. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections and allowance of claims.

Furthermore, with regard to the Examiner's Response to Arguments part (B) (Office Action, p. 3) Applicant respectfully disagrees.

CONCLUSION

Applicant asserts that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art to this Office Action (and/or any previous office action(s)) (hereinafter "Office Action(s)"). While many other claim elements and/or bases for rejection were not discussed, as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art, and Applicant reserves the opportunity to more particularly traverse, remark and/or distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to the Office Action(s)' objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to other Office Action(s) objection(s) and/or rejection(s) as to any other claim element(s), any such re-assertion(s) of remarks are not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim element(s), and no such commonality is admitted as a consequence of any such re-assertion(s) of remarks. Consequently, the reference(s) cited the Office Action(s) do not result in the claimed invention(s), there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed invention(s) are not admitted to be prior art. Also,

Applicant does not accept, admit, and/or concede to any assertions, (mis)characterizations (e.g., of claims, references, and/or otherwise), and/or Official Notice(s) in the Office Action(s). As such, Applicant does not concede that any claim element(s) have been anticipated and/or rendered obvious by any of the cited reference(s) and/or any Official Notice in the Office Action(s). Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-268, all: overcome all rejections and/or objections as noted in the Office Action(s), are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

Authorization

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 19778-002. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 19778-002.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,
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